

REMARKS

The following remarks and the above amendments are submitted to address all issues in this case, and to put this case in condition for allowance. Applicant amends the claims in this case to cancel some claims and make others independent in form and to better define the subject matter of the present invention; no new matter is added in these amendments. After the above amendments, claims 2-9, 12, 13, and 16-23 are pending in the application. Claims 7, 12, 16, 21 and 23 are independent.

Applicant has studied the Office Action Mailed July 1, 2003, and has the following remarks.

35 U.S.C. §112

The Examiner rejected claims 16 and 17 as failing to comply with the written description requirement as the Examiner alleges the original disclosure does not provide support for the backing sheet being twistable relative to the rigid base via the flexible material. Applicant respectfully traverses the rejection as the original disclosure provides for the twisting of the backing sheet relative to the rigid base via the flexible material. “The pack portion 12 of the wheeled-backpack 10 is formed of a woven nylon material or other suitable flexible material. . . .” Page 8, lines 11-13. “In another alternative embodiment, the towing member could simply be attached to the baggage without directly engaging the base portion. In such a configuration, the backpack itself would act as a pivotal connection.” Page 16, Lines 15-19.

Therefore, a connection between the backing sheet and the rigid base via the flexible fabric of the pack portion is disclosed and allows for the twisting of the backing sheet relative to the rigid base. Applicant therefore asserts that the required support for claims 16 and 17 exists in

the specification. Applicant respectfully requests the Examiner withdraw his § 112 rejection to claims 16 and 17.

The Examiner rejected claim 4 as being indefinite as the Examiner alleges that it is unclear what is meant by “immediate the at least two wheels.” Applicant respectfully traverses the rejection as claim 4 as presented reads that “the towing member is curved and is connected to the base intermediate the at least two wheels.” (emphasis added.) In this context the term “intermediate” is roughly equivalent to the term “between.” Applicant asserts that one of ordinary skill in the pertinent art would fully understand the position of the connection between the towing member and the rigid base as being between the two wheels that are attached to the rigid base. Given an accurate reading of claim 4 and the assertions that one of ordinary skill in the art would clearly comprehend the language of claim 4, Applicant respectfully requests the Examiner withdraw his § 112 rejection to claim 4.

35 U.S.C. §§ 102/103

Mao

The Examiner rejected prosecution claims 2-22 based on 35 U.S.C. §102(e) as anticipated by Mao (United States Patent No. 6,279,706).

Applicant herewith submits a new Declaration of Prior Invention in accordance with 37 C.F.R. § 1.131 (“Rule 131”) as a means to testify to a date of actual reduction to practice for the present invention that is earlier than the effective date of the Mao reference.

In support of the sufficiency of Applicant’s new Declaration for establishing a date of invention prior to the Mao reference, Applicant respectfully reminds the Examiner of the following rules of law with respect to the use of Rule 131.

Rule 131 states: “The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence. . . .” 37 CFR § 1.131(b) (emphasis added). Diligence does not need to be shown so long as the declaration shows actual reduction to practice prior to the effective date of the cited reference. In this case, Applicant’s Declaration does show an actual reduction to practice prior to the filing date of the Mao reference.

While it is also unnecessary to show conception in a Rule 131 declaration, so long as an actual reduction to practice is shown, Applicant notes that the Declaration clearly shows conception as it shows a prototype backpack actually reduced to practice. There can be no actual reduction to practice of an invention without a conception. Conception need not be prior to the reduction to practice, as the events could conceivably occur simultaneously. Yet once a physical embodiment has been produced, as is shown in Applicant’s Declaration, and the physical embodiment has been recognized as solving a particular problem and serving a useful purpose, there necessarily has been a conception of an invention. The Declaration includes evidence of the actual reduction to practice of an embodiment of the invention in the form of photographs thereof, as well as statements by the inventor of conception and, in addition, statements of the recognition of the physical embodiment’s usefulness in solving a problem that was to be addressed by the conception. There is no question that the Declaration sufficiently shows conception and reduction to practice of an invention, and that the Declaration need not show diligence, because under Rule 131 diligence is not an issue when an actual reduction to practice has been shown to have occurred prior to the effective date of the reference cited by the examiner.

Applicant asserts that the new Rule 131 Declaration submitted herewith is sufficient to demonstrate the invention was both conceived and reduced to practice prior to the effective date of Mao. That being shown, Mao is removed as a § 102(e) reference. Applicant notes that prosecution claims 2, 3, 12, 13, and 18-23 were only rejected in light of Mao. Therefore, applicant respectfully requests the Examiner's rejection of claims 2, 3, 12, 13, and 18-23 be withdrawn, and that they be allowed to continue to issuance. Additionally, Applicant respectfully requests that the Examiner's § 102(e) rejection of each of claims 2-22 be withdrawn.

Sadow and Bergman

The Examiner rejected claims 7, 8, and 9 based on 35 U.S.C. §103(a) as being rendered obvious by Sadow (U.S. Pat. No. 6,298,964) in view of Bergman (U.S. Pat. No. 5,109,961). Applicant respectfully traverses the rejection as Sadow and Bergman, either alone or together, fail to render obvious each element and relationship of these claims. Particularly, neither Sadow or Bergman provide a resiliently flexible backing sheet attached to the towing member and inside the pack for movement relative to the rigid base.

By the statement that Sadow shows a resilient backing sheet, it appears that the Examiner has misunderstood the nature of the resiliently flexible backing sheet of claim 7 of the present application. Sadow shows no resiliently flexible backing sheet attached to the towing member and the pack. Rather, the element of Sadow's invention that the Examiner has alleged to be a resiliently flexible backing sheet is simply the wall of Sadow's pack. The Examiner states: "Sadow teaches a pack having . . . a resilient backing sheet 14 for pivotal movement together with the handle as shown in Fig. 9." ¶ 4. Sadow makes quite clear that element 14 of Fig. 9 is not attached to the pack wall but, in fact, is the pack wall. "The portable carrying case 10 which includes back walls 12-14, top and bottom walls 16, 18 and opposed ends walls 20, 22. . . ."

Sadow, col 7, lines 11-13. In other places throughout Sadow, element 14 is referred to as “the rear wall” and “the back wall.”

The Examiner’s use of the back wall, as the resiliently flexible backing panel necessarily prevents the device of Sadow from having “a pack constructed of flexible material, the flexible material enclosing a hollow interior of the pack” which is also an element of claim 7. Without the rear wall, the “pack” of Sadow no longer encloses a hollow interior, with the rear wall as part of the pack, the rear wall cannot be attached to the inside of the pack (as it is the pack). Still further it makes the same component both “flexible” and “resiliently flexible” rendering the “resiliently” language meaningless (an inappropriate interpretation). Therefore, the Examiner’s assertion of components cannot anticipate or render obvious independent claim 7.

Further, the Examiner provides that the rigid base is portion 23 of Sadow. Applicant notes that reference 23 of Sadow refers to a compartment. The only rigid portion of Sadow on the base is element 74 (stiffening member). However, neither the handle nor the back wall of Sadow can rotate relative to the stiffening member (See FIG. 5 of Sadow).

The Examiner suggests that Bergman may be necessary to teach a rigid base; however, Bergman fails to provide the resiliently flexible backing sheet attached to both the towing member and the pack.

Since claims 8 and 9 depend from claim 7, Applicant asserts that claims 7, 8, and 9 are allowable over Sadow and Bergman, and respectfully requests that the Examiner withdraw the § 103 rejection to claims 7, 8, and 9 in light of Sadow and Bergman.

Lin and Miyoshi

The Examiner rejected claims 7 and 8 based on 35 U.S.C. §102(a) as being anticipated by Lin (U.S. Pat. No. 6,179,101). Additionally, the Examiner rejected claims 4-6, 14 and 15 based on 35 U.S.C. §103(a) as being rendered obvious by Lin in view of Miyoshi (U.S. Pat. No. 5,908,093), alleging Lin meets all limitations except the curved towing member, which is taught by Miyoshi. Applicant respectfully traverses the rejection as Lin and Miyoshi, either alone or together, fail to anticipate or to render obvious each element and relationship of claims 4-8 as amended. The rejection of claims 14 and 15 has become moot because these claims have been cancelled.

Just as for the rejection based on Sadow and Bergman, Lin and Miyoshi fail to disclose the resiliently flexible backing sheet of claim 7. Lin, just like Sadow and Bergman, fails to show a resiliently flexible backing sheet attached to the towing member and inside the pack. The Examiner alleges: “Lin teaches . . . a flexible backing sheet 16 as shown in [Fig.] 13.” ¶ 5. As discussed above with respect to Sadow, Lin shows the towing member attached to the wall of the pack. Specifically, Lin states that the invention comprises “a suitcase body 10 including a foldable middle portion 11 formed between the lower shell 15 and the upper shell 16 of the suitcase body 10.” Lin, col. 3, lines 1-3. The element 16 in Lin that the Examiner has identified as the resiliently flexible backing sheet of the present invention is continuously referred to throughout Lin’s disclosure as “the upper shell 16” and “the upper shell 16 of the suitcase 10.” In Lin the term “shell” is essentially identical to the wall of the suitcase body or pack. Clearly, in Lin’s disclosure the element 16 is a wall of the pack. Thus, Lin in no way anticipates all of the elements of claim 7 of the present invention, and therefore cannot anticipate any of the claims 4-6, and 8 each of which depend from claim 7.

According to the discussion above, Applicant asserts that claims 4-8 are not anticipated by Lin, but are allowable over Lin, and respectfully requests the Examiner withdraw the § 102

rejection of claims 4-8 in light of Lin. Additionally, there being no further rejections of claims 7 and 8, Applicant respectfully requests that these claims be allowed to issue.

In the § 103 rejection of claims 4-6, the Examiner has relied on Lin to show all claim limitations of claims 4-8, except the curved towing member. As Miyoshi still does not provide the resiliently flexible backing sheet of the present invention because there is no disclosure that Miyoshi's partition is flexible, nor that its purpose is anything like that of the backing sheet of the present invention.

According to the discussion above, Applicant asserts that claims 4-8 are not rendered obvious by Lin in light of Miyoshi, and are allowable over both Lin and Miyoshi.

Miyoshi, Hildebrandt or Carrigan, Jr., and Sadow

The obviousness rejections of claims 10 and 11 have been rendered moot by the cancellation of these claims.

Gelb, JP9-65929 and JP9-285329

The Examiner rejected claims 16 and 17 based on 35 U.S.C. §103(a) as being rendered obvious by Gelb (U.S. Pat. No. WO9,638,066) in view of JP9-65929, and additionally based on 35 U.S.C. §102(b) as being anticipated by JP9-285329. Applicant respectfully traverses these rejections as Gelb, JP9-65929, and JP9-285329, either alone or in combination, fail to render obvious each element and relationship of these claims, particularly the resiliently flexible backing sheet, twistable relative to the rigid base. The Examiner has alleged that both JP '929 and JP '329 teach a backing sheet (elements 22 and W, respectively). ¶ 9 and ¶ 10. Applicant respectfully contends that neither JP '929 or JP '329 discloses anything resembling the resiliently flexible backing sheet, twistable relative to the rigid base as is disclosed in the present

application. Applicant bases his argument on the pictures of JP '929 and JP '329 as no translation has been provided and no indication was made by the Examiner of reliance on the text of the references.

Gelb provides no indication of a resiliently flexible backing sheet. JP '929 shows an element 22 that is a zipper pouch tethered by one corner via a narrow strap to an inside wall of a pack. It is not shown that this element 22 be attached to the side of the pack to which are attached the shoulder straps, as is required by claim 16. In fact, it is expressly shown attached to a different side. Plus, there is no showing or teaching that JP '929 that the pouch is twistable relative to a rigid base via the flexible material of the pack. The pouch in fact cannot flex using the material of the pack, it would move using the strap (or would probably simply be loosely held). In short, the tethered, zippered pouch 22 of JP '929 does not render obvious the backing sheet of the present invention.

Element W of JP '329 is designed to wrap around the rigid base and be affixed thereto with what appears to be a hook and loop fastening system 26. As shown in Figures 1 and 2 of JP '329, even when not affixed to the rigid base by the hook and loop fastening system, element W is fixed to the rigid base behind the wheels R. Because it is fixed to the rigid base by at least two points corresponding to each of the wheels, the element W has no means to twist relative to the rigid base. Therefore, JP '329 does not anticipate claims 16 and 17.

According to the discussion above, Applicant respectfully requests that the §§ 102/103 rejections of claims 16 and 17 in light of Gelb, JP '929, and JP '329 be removed, and because there are no further rejections of these claims, that they be allowed to issue.

Conclusion

In light of the above, Applicant respectfully requests entrance of the above amendment in conjunction with this request for reconsideration and allowance of all pending claims so that this case can pass on to issue.

As a final point, there is also included herewith a petition for a two month extension of time and the associated petition fee. It is believed no other fees are due in conjunction with this filing; however, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this amendment, including any claims fees and/or extension fees to/from our **Deposit Account No. 50-0975**.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,
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